REMARKS

The Examiner has rejected claims 1 and 12 under 35 U.S.C. 112, paragraph 1, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, in that the limitation "retrieving the optically encoded information" is not supported by the specification.

Claim 1 currently states "retrieving said optically encoded or electronically stored information..." while claim 12 currently states "retrieve information...". It is apparent from the above that the Examiner finds fault with the term "retrieve" in that it cannot be found in the specification as filed.

Applicants refer the Examiner to *In re Wertheim*, 191 USPQ 90 (CCPA 1976), where the court stated "If lack of literal support alone were enough to support a rejection under § 112, then the statement of *In re Lukach, supra, 58 CCPA at 1235, 442 F 2d at 969, 169 USPQ at 796*, that 'the invention claimed does not have to be described in ipsis verbis in order to satisfy the description requirement of § 112,' is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in ipsis verbis is insufficient."

The subject invention relates to getting information from a tag. The tag is disclosed as being an RFID tag, a barcode tag, or some other form. An RFID tag, upon being addressed by a reader, transmits its stored information, while a barcode tag is optically scanned. Claim 1 as originally filed stated "receiving information". Applicants submit that while the term "receiving" would be accurate with respect to an RFID tag, it is not accurate with respect to a barcode tag. Applicants have amended the claims to use the term "retrieving" which Applicants believe more accurately describes the process of getting the information from the tag. While the term "retrieve" (or "retrieving") does not appear in the specification as filed, as per *In re Wertheim*, it is nonetheless supported by the specification as filed.

The Examiner has rejected claims 1-8, 11-19 and 22 under 35 U.S.C. 101 "because the claimed invention is directed to non-statutory subject matter." The Examiner then goes on for the next 2-1/2 pages with a dissertation concerning "technical arts" (probably taken from the Examination Guide). Applicants would like to refer the Examiner to the BPAI Precedential Opinion *Ex parte Lundgren*, Appeal No. 2003-2088, heard April 20, 2004, in which the Board unequivocally states "there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to create one." Albeit, the Examiner follows the dissertation with the statement

"In the present application, method claim 1 is in the technological art (i.e., electronically storing the physical object...), however, claim 1 fails to produce a useful, concrete and tangible result (i.e. creating the profile of the of the person). From this it can be seen that the broadest reasonable equivalent disclosed fails to recite a concrete and tangible result test and therefore recites non-statutory subject matter under 35 U.S.C. 101."

Applicants have read this statement by the Examiner numerous times and have no idea what the Examiner is trying to say. Firstly, the claim does relate to "electronically storing the physical object..." as noted by the Examiner, rather, the claimed invention relates to modifying an electronically accessed unique profile of a person with an object profile obtained from information retrieved from a tag concerning an object associated with the person. The specification is quite clear as to the usefulness of such a profile, to wit, at page 1, lines 20-22, "Personality profiles that reflect such traits are very useful for numerous purposes, e.g., in advertising and product marketing". Other uses may be, for example, by a travel agency for planning a vacation for the person using the modified profile.

In view of the above, Applicants submit that claims 1-8, 11-19 and 22 are indeed statutory, are respectfully request that the Examiner's 35 U.S.C. 101 rejection be withdrawn.

The Examiner has rejected claims 1-7, 9-18 and 21-22 (and arguably claim 20) under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,535,889 to Headrick et al. in view of U.S. Patent 6,571,279 to Herz et al. The Examiner has further rejected claims 8 and 19 under 35 U.S.C. 103(a) as being unpatentable over Headrick et al. in view of Herz et al., and further in view of U.S. Patent 6,407,665 to Maloney.

The Headrick et al. patent discloses a system and method for obtaining and displaying an interactive electronic representation of a conventional static media object in which a computer display includes an image of an object (e.g., hat 706) to be, for example, purchased by a user of the computer. "When a user moves the screen pointer 802 across a screen region adjacent to or encompassing hat 706, detailed product text information may be displayed...." (col. 11, lines 31-33).

The Herz et al. patent discloses a location enhanced delivery system "which customizes the information that is displayed to an information recipient based on optimizing a match between information purveyors, such as advertisers, and the information recipients who are local to an information delivery system" (col. 1, lines 48-54), in which "user profiles may be in part generated/updated in accordance with the target object profiles the users visit...." (col. 18, lines 34-55).

The subject invention relates to a method for modifying a unique profile of a person by making use of at least one physical object associated with the person and having a tag containing optically encoded or electronically stored information concerning the physical object. Applicants have found that physical items, memento's, knick-knacks and other personal possessions reflect upon the owner's tastes, likes and personality. "Smart labeling" may then be used to gather information of objects owned by a person. "Smart labeling" preferably includes attaching to or embedding Radio Frequency Identification (RFID) tags into objects. These RFID tags contain information concerning the object to which the tag is attached/embedded. This information may be descriptive of the object or may be directors for pointing a reader of the information to a location (e.g., website) for retrieving an object profile. Alternatively, the information may be contained in a barcode.

The subject invention, as claimed in claim 1, includes "retrieving said optically encoded or electronically stored information related to the physical object from said tag", "electronically accessing an object profile in accordance with the information retrieved from the tag", "electronically accessing a unique profile associated with the person", and "modifying the unique profile in accordance with the object profile".

Applicants submit that the combination of Headricks et al. and Herz et al. neither disclose or suggest physical objects,

associated with a person, containing information-carrying tags, and the retrieving of such information from these tags such that an object profile contained in or identified by the information may be used to modify a unique profile of the person owning the physical objects.

In the current Office Action, the Examiner now states "Headricks et al. does disclose the step of retrieving of the user's information (col. 9, line 54 through col. 10, line 13), and Hertz does disclose the concept of modifying a user's profile. (col. 18, lines 34-55)."

Applicants submit that Headricks et al. discloses the use of a computer to display an object that the user may desire to purchase, and dragging a cursor across an area of the screen adjacent or over the object to display detailed product text information. However, Applicants stress that Headricks et al. neither discloses nor suggests physical objects in the possession of a person, these physical objects having tags containing information concerning the object, and retrieving this information.

Applicants would like to remind the Examiner that it is impermissible to pick and choose words from a limitation in a claim in order to find a reference and then to reject the claim based on only these picked and chosen words. Rather, each claim limitation must be considered in its entirety.

In the present case, claim 1 does not merely state retrieving information, but rather states "at least one physical object associated with the person and having a tag containing optically encoded or electronically stored information concerning the physical object", "retrieving said optically encoded or electronically stored information related to the physical object from said tag", and "electronically accessing an object profile in accordance with the information retrieved from the tag". Applicants submit that it should be apparent that Headricks et al. is not concerned with physical objects in the possession of a person; just referring to the Title should make this clear, to wit, "A SYSTEM AND METHOD FOR OBTAINING AND DISPLAYING AN INTERACTIVE ELECTRONIC REPRESENTATION OF A CONVENTIONAL STATIC MEDIA OBJECT".

While Herz et al. arguably discloses "user profiles may be in part generated/updated in accordance with the target object profiles the users visit...." (col. 18, lines 34-55), the combination of Headricks et al. and Herz et al. neither discloses or suggests retrieving information from a tag of a physical object associated with a person, using this information to access an object profile, and modifying a unique profile of the person based on the accessed object profile.

The Maloney patent discloses an object tracking system with non-contact object detection and identification.

First, Applicants submit that Maloney is not analogous to the combination of Headricks et al. and Herz et al. in that the combination of Headricks et al. and Herz et al. are related to computer systems and the presentation of information in the computer system.

Further, Applicants submit that the combination of Maloney with Headricks et al. and Herz et al. would be directed toward items that are not associated with (or in the possession of) the user, but rather to objects that the user may desire to purchase. Hence, there is no incentive for using the combination of Maloney/Headricks et al./Herz et al. for objects already associated with the user (or in the user's possession).

In view of the above, Applicants believe that the subject invention, as claimed, is not rendered obvious by the prior art, either individually or collectively, and as such, is patentable thereover.

Applicants believe that this application, containing claims 1-22, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

by 
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